

# **Relevant Documents from**

# **‘073 Application**



**Enzo Biochem, Inc.**  
575 Fifth Avenue  
New York, NY 10017  
212.956.0876  
Fax: 212.856.0878

**VIA FACSIMILE & FEDERAL EXPRESS**

703-415-1618

March 11, 1993

Cantwell & Paxton, Inc.  
Suite 1003  
2001 Jefferson Davis Highway  
Arlington, VA 22202

**Attention: Mmes. Pat Paxton and Beverly Floyd**

**RE: U.S. Patent Application Serial No. 07/869,073**

**Filed: April 10, 1992**

**Inventor: Pravinkumar B. Sehgal**

**Title: Species of Interferon, A Process for Their Preparation and Species of Interferon Prepared Thereby**

**Our Reference: Enz-2 (C3)**

Dear Pat and Beverly:

Could you let me know, preferably by facsimile confirmation, the status of the above-identified U.S. application which was re-filed last April? We have received no correspondence except for the Filing Receipt issued in June 1992. For your use in making this inquiry, we have enclosed an executed Power to Inspect and Make Copies.

In addition, could you please file the following documents in connection with this application:

1. Change of Correspondence Request;
2. Request to Correct Filing Receipt; and
3. Revocation of Previous Powers of Attorney and Appointment of New Power of Attorney.

Mmes. Pat Paxton and Beverly Floyd  
Cantwell & Paxton  
March 11, 1993  
Page 2

A return postcard is also enclosed in connection with the above documents. If possible, please have the clerk of Group 1800 (or other authorized Patent Office personnel) stamp the postcards. You may return the stamped postcards to us when you send me a paid receipt for this service, for which my personal check no. 1356 for \$25.00 is enclosed. Please let me know if this amount is sufficient.

We look forward to receipt of the status information and the stamped return postcards.

Cordially,



Ronald C. Fedus  
Patent Counsel

Enclosures

**MEMORANDUM**

To: File

From: Ronald C. Fedus

Date: March 16, 1993

Re: Enz-2 (C3) [Interferon et al.]  
Enz-26 (C2) [Novel One Step Method et al.]  
Enz-7 (C2)(P)(C2) [Soluble Assay et al.]

Mrs. Pat Paxton of Cantwell & Paxton, our Washington associates telephoned me today to inform me that the interferon application [Enz-2 (C3)] was presently in the hands of Examiner Shelly Guest. The papers effecting changes in power and correspondence address had been filed by Pat.

With respect to the two other cases, Enz-26 (C2) and Enz-7 (C2)(P)(C2), Pat indicated that these applications were in the hands of the petitions examiner(s) who should act upon them in due course.

*Rf*



**Enzo Biochem, Inc.**  
575 Fifth Avenue  
New York, NY 10017  
212.856.0876  
Fax: 212.856.0878

March 17, 1993

Dr. Pravinkumar B. Sehgal  
Department of Microbiology  
New York Medical College  
Basic Sciences Building  
Valhalla, New York 10595

**Re: U.S. Patent Application Serial No. 07/869,073**  
**Filed April 10, 1992 as a continuation of**  
**Serial No. 07/191,517, filed May 6, 1988**  
**Inventor: Pravinkumar B. Sehgal**  
**For: SPECIES OF INTERFERON, A PROCESS FOR THEIR**  
**PREPARATION AND SPECIES OF INTERFERON PREPARED THEREBY**  
**Our Reference No.: Enz-2 (C3)**

Dear Dr. Sehgal:

Further to our letter of last week, we have just been informed by our Washington associates that the new continuation application, above-identified, is presently in the hands of the patent examiner who handled the previous application.

We expect to receive a communication from the examiner in the next few weeks and will immediately apprise you when it is received.

Cordially,

A handwritten signature in black ink, appearing to read "Ronald C. Fedus".

Ronald C. Fedus  
Corporation & Patent Counsel



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/669,073	04/10/92	SEHGAL	P ENZ-2
		EXAMINER	GUEST, S
		ART UNIT	PAPER NUMBER
		1812	22
		DATE MAILED:	03/18/93

Please do not contact the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

RECEIVED  
MAY 23 1993  
RONALD C. FEDUS

This application has been examined  Responsive to communication filed on 4/10/92  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s). 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice re Patent Drawing, PTO-848.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, Form PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1.  Claims 12, 18, 23-26 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims 1-11, 13-17, 19-22, 27-40 have been cancelled.

**CONFIDENTIAL & PRIVILEGED**

**MEMORANDUM**

To: Drs. Elazar Rabbani & Dean Engelhardt  
From: Ronald C. Fedus  
Date: March 23, 1993  
Re: Enz-2 (C3) [Interferon et al.]

After almost one year after receiving the Filing Receipt for this application, we received the attached Office Action that was issued on March 18, 1993.

In general, the Office Action contained a number of issues which were raised in the previous application. These include:

1. lack of patentable utility (§101) page 2
2. lack of enabling disclosure  
(§112, 1st ¶) pages 2-3
3. indefiniteness (§112, 2nd ¶) pages 3-4
4. anticipation (§102(a) & (f)) pages 5-6
5. obviousness (§103) pages 7-8

At the outset, I would suggest that we confer on the claims which are pending in this application for the purpose of determining their suitability in terms of language and scope.

As far as the issues raised in the Office Action, I think that the indefiniteness issue (§112, 2nd ¶) can be easily handled by minor amendments to the claims. The anticipation rejection by Weissenbach et al. can also be easily handled by a so-called Rule 131 Declaration to swear behind the reference. I have some laboratory notebook pages from Dr. Pravinkumar Sehgal and will probably need some input from the inventor in order to draft and submit a proper declaration. With respect to the anticipation rejection under §102(f), this is an issue which can likewise handled by a declaration in the name of Dr. Sehgal as the sole inventor.

Please let me know as soon as you have had an opportunity to review the Office Action. I would like to schedule an appointment with Dr. Sehgal in the coming weeks so that we can prepare a substantial response to overcome all of the remaining issues.

*R.W.M.*

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TO	Ron	DATE	9/23	TIME	AM
FROM	Shelly Ceimak	AREA CODE	703	PM	
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PHONED <input type="checkbox"/> CALL BACK <input type="checkbox"/> RETURNED <input type="checkbox"/> WANTS TO SEE YOU <input type="checkbox"/> WILL CALL AGAIN <input type="checkbox"/> WAS IN <input type="checkbox"/> URGENT <input type="checkbox"/>					

**MEMORANDUM**

To: File  
From: Ronald C. Fedus  
Date: September 24, 1993  
Re: Enz-2 (C3) [Interferon et al.]

On this date I telephoned Examiner Shelly Cermak [formerly Shelly Guest] of Group 1812 [Tel. 703-308-3154] who had telephoned the day before.

Examiner Cermak was inquiring as to whether we had filed a response to the March 18, 1993 Office Action. I informed her that we were preparing to file a response but that the application became unintentionally abandoned. I also indicated to Examiner Cermak that we were taking immediate steps to revive the application, and would be filing a Petition to Revive as well as an appropriate response sometime next month.

*RJ*



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/650,872	07/16/93	SEHLMAN	P ENZ 2 (KGB)

RONALD C. FEINUS, CORP. PATENT COUNSEL  
ENZO THERAPEUTICS, INC.  
C/O ENZO BIOCHEM, INC.  
575 FIFTH AVENUE (18TH FLOOR)  
NEW YORK, NEW YORK 10017

18M1/1004

QUEST	EXAMINER
	SEHLMAN, S
ART UNIT	PAPER NUMBER
1612	26
DATE MAILED:	

10/04/93

NOTICE OF ABANDONMENT

This application is abandoned in view of:

- Applicant's failure to respond to the Office letter, mailed 3/15/93.
- Applicant's letter of express abandonment which is in compliance with 37 C.F.R. 1.138.
- Applicant's failure to timely file the response received \_\_\_\_\_ within the period set in the Office letter.
- Applicant's failure to pay the required issue fee within the statutory period of 3 months from the mailing date of \_\_\_\_\_ of the Notice of Allowance.

The issue fee was received on \_\_\_\_\_.

The issue fee has not been received in Allowed Files Branch as of \_\_\_\_\_.

In accordance with 35 U.S.C. 151, and under the provisions of 37 C.F.R. 1.316(b), applicant(s) may petition the Commissioner to accept the delayed payment of the issue fee if the delay in payment was unavoidable. The petition must be accompanied by the issue fee, unless it has been previously submitted, in the amount specified by 37 C.F.R. 1.17 (l), and a verified showing as to the causes of the delay.

If applicant(s) never received the Notice of Allowance, a petition for a new Notice of Allowance and withdrawal of the holding of abandonment may be appropriate in view of Delgar Inc. v. Schuyler, 172 U.S.P.Q. 513.

5.  Applicant's failure to timely correct the drawings and/or submit new or substitute formal drawings by \_\_\_\_\_ as required in the last Office action.

The corrected and/or substitute drawings were received on \_\_\_\_\_.

6.  The reason(s) below.

RECEIVED

OCT - 6 1993  
10/6/93

RJ

*Robert J. Hill Jr.*  
ROBERT J. HILL, JR.  
SUPERVISORY PATENT EXAMINER  
GROUP 1800



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

**Address : COMMISSIONER OF PATENTS AND TRADEMARKS**  
Washington, D.C. 20231

Journal Number 1 - 1990-08-14

07/869,073 04/10/92 SEHQAU

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ELAINE P. BRENNER  
ENZO BIOCHEM, INC.  
60 EXECUTIVE BOULEVARD  
FARMINGDALE, NY 11765

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It is also important to note that the results of the study were not limited to the effects of the intervention on the patients' physical health.

0.37158(10)

This application has been examined  Responsive to communication filed on 4/10/192  This action is made final.

A shortened statutory period for response to this action is set to expire 5 month(s), 0 days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133.

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- Notice of References Cited by Examiner, PTO-892.  
 Notice of Art Cited by Applicant, PTO-1449.  
 Information on How to Effect Drawing Changes, PTO-1474.

Notice re Patent Drawing, PTO-948.  
 Notice of Informal Patent Application, Form PTO-152.

## **Part II SUMMARY OF ACTION**

1.  Claims \_\_\_\_\_ 12, 18, 23-26 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims 1-11, 13-17, 19-22, 27-40 have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 12, 18, 23-26 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.65 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.54 these drawings are  acceptable.  not acceptable (see explanation or Notice re Patent Drawing, PTO-946).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed on \_\_\_\_\_, has been  approved.  disapproved (see explanation).

12.  Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other \_\_\_\_\_

FD NO. ENZ-2  
FD# 6/18/93 BY  
ENZO BUCCHI, INC.  
PO BOX 200, MINGDALE, NY 11735

**EXAMINER'S ACTION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Pravinkumar B. Sehgal )  
Serial No.: 07/869,073 ) Group Art Unit: 1812  
Filed: April 10, 1992 ) Exam'r: Shelly Guest Cermak  
Title: SPECIES OF INTERFERON, A PROCESS FOR )  
THEIR PREPARATION AND SPECIES OF )  
INTERFERON PREPARED THEREBY )

June 16, 1994  
575 Fifth Avenue (18th Floor)  
New York, New York 10017

**FILED BY EXPRESS MAIL**

Honorable Commissioner  
of Patents and Trademarks  
Washington, D.C. 20231

**Box DAC**

**Attention: Office of Deputy Assistant Commissioner  
for Patents  
2121 Crystal Drive  
Crystal Park 2 - Suite 913  
Arlington, Virginia 22202**

**PETITION TO REVIVE  
AN UNINTENTIONALLY ABANDONED  
APPLICATION UNDER 37 C.F.R. §1.137(b)**

Dear Sirs:

Applicant submit this Petition to the Commissioner under the provisions of 37 C.F.R. §1.137(b) to revive the above-identified application which was unintentionally abandoned.

The above-identified application became unintentionally abandoned after July 18, 1993, which was the date that a response to a March 18, 1993 Office Action was due. A copy of the Notice of Abandonment issued on October 4, 1993 is attached to this Petition as Exhibit A.

It is hereby requested that this application be revived because it was unintentionally abandoned and there was no intent to abandon the application. Submitted concurrently herewith and attached as Exhibit B is a proposed response in the form of a Request for Continuation Application Under 37 C.F.R. §1.60.

Enz-2(C3)

EXPRESS MAIL CERTIFICATE	
"Express Mail" Label No. EF414878015	
Deposit Date	JUNE 16, 1994
I hereby certify that this paper and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington DC 20231	
JUNE 16, 1994	
Ronald C. Fedir	

Pravinkumar B. Sehgal  
Serial No. 07/869,073  
Filed: April 10, 1992  
Page 2 (Petition to Revive an Unintentionally Abandoned Application  
Under 37 C.F.R. §1.137(b) - June 16, 1994)

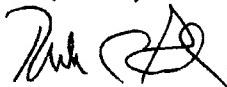
The fee for filing a Petition to Revive an Unintentionally Abandoned Application Under 37 C.F.R. §1.137(b) is \$585.00 for a small entity. Small entity status was previously established by a duly executed Verified Statement (Declaration) Claiming Small Entity Status (37 CFR §§1.9(f) and 1.27(c)) - Small Business Concern, a copy of which accompanies the Continuation Request (Exhibit B). The Patent and Trademark Office is hereby authorized to charge Deposit Account No. 05-1135 for the requisite fee of \$585.00 set forth in 37 C.F.R. §1.17(m). The Patent and Trademark Office is further authorized hereby to charge Deposit Account No. 05-1135 for any other fees required in connection with this Petition and to credit any overpayment thereto.

A duplicate copy of this Petition (but without attached Exhibits A and B) is also submitted herewith.

Favorable action on this Petition is earnestly solicited.

If helpful to the processing of this Petition or the accompanying Continuation Request, the undersigned may be contacted by telephone during the daytime hours at 212-856-0876.

Respectfully submitted,



Ronald C. Fedus  
Registration No. 32,567  
Attorney for Applicant

ENZO THERAPEUTICS, INC.  
c/o Enzo Biochem, Inc.  
575 Fifth Avenue (18th Floor)  
New York, New York 10017  
Tel. (212) 856-0876



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER OF  
PATENTS AND TRADEMARKS  
Washington, D.C. 20231

JLB/JVN/jlb.8

Paper No. 29

Ronald C. Fedus, Corp. Patent Counsel  
Enzo Therapeutics, Inc.  
C/O Enzo Biochem, Inc.  
575 Fifth Avenue (18th Floor)  
New York, New York 10017

**COPY MAILED**

AUG 31 1994

OFFICE OF PETITIONS  
IN PATENTS

In re Application of :  
Pravinkumar B. Sehgal :  
Serial No. 07/869,073 :  
Filed: April 10, 1992 :  
Attorney Docket No. ENZ-2(C3) :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed June 16, 1994, to revive an unintentionally abandoned application.

The petition is granted.

Since this application is being revived for purposes of continuity only and since continuity has been established by this decision reviving the application, the application is again abandoned in favor of the continuing application.

If the continuing application is one filed under 37 CFR 1.60 or 1.62, applicant must file a written notice in the continuing application within ONE MONTH from the mail date of this decision indicating that the present application has been revived for purposes of continuity and, accordingly, that the continuing application complies with the copendency requirements of the rules. The failure to file such a notice may result in the continuing application being inadvertently returned to applicant.

The statement that the "abandonment was unintentional" does not comply with 37 CFR 1.137(b).<sup>1</sup> However, the statement presented will be accepted and construed as meaning that the "delay was unintentional." If this is an incorrect interpretation in view of the new rules, petitioner is required to provide a statement to that effect.

<sup>1</sup> Effective September 20, 1993. See "Changes in Procedures for Revival of Patent Applications and Reinstatement of Patents," published at 1154 Official Gazette 4 (September 14, 1993).

Serial No. 07/869,073

Page 2

The file is being forwarded to Group 1800.

*J. V. Nase*  
Jeffrey V. Nase, Director  
Office of Petitions  
Office of the Assistant Commissioner  
for Patents